

Office Action Summary

Application No.

09/865,109

Applicant(s)

PAJUNK ET AL.

Examiner

Eduardo C. Robert

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3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-30 is/are pending in the application.
- 4a) Of the above claim(s) 19-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I, claims 1-15, in Paper No. 8 is acknowledged. It is noted that claims 16 and 18 are part of Group I. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without traverse** (MPEP § 818.03(a)).

Claims 19-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without traverse**.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embodiment wherein the piston and the engaging section are formed as separate parts, as per claim 13, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of two parts:

- a) A separate letter to the Draftsman in accordance with MPEP § 608.02(r); and

b) A print or pen-and-ink sketch showing changes in red ink in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office Action, and may not be deferred.

Specification

The disclosure is objected to because of the following informalities: the various sections of the specification should be preceded by their respective headings. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 1 and 2, respectively, “the application of bone cement” and “the reception” each lacks a prior antecedent.

In claim 10, line 2, “and/or” is indefinite because it is unclear what limitation such language places on the claimed subject matter.

In claim 11, lines 2 and 3, respectively, “the other tooth flanks” and “the other flank of the thread section” each lacks a prior antecedent. Also, in line 3, “and/or” is indefinite because it is unclear what limitation such language places on the claimed subject matter.

In claim 16, line 6, "the side" lacks a prior antecedent.

In claim 18, line 2, "a pplication" should be changed to -- application --.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kokernak.

Kokernak discloses an apparatus comprising a housing 10 having cylinder 14; a piston arranged in a longitudinally displaceable manner in the cylinder (see Figures 1 and 4); an exit aperture 16 formed in the cylinder; a screw movement (see Figures 1, 2, and 3); and an arrangement (see Figures 2 and 3). The piston has an engaging sections or threads that engages into a cooperating toothed arrangement or threads 49 provided at the housing 10 such that the longitudinal displacement of the piston is effected when the engaging section is turned (see col. 3, lines 11-14). The engaging section or threads and the cooperating toothed arrangement or threads 49 can be uncoupled (see col. 3, lines 11-14 and Figures 1-3). The cooperating toothed arrangement or threads 49 can be moved in a direction substantially perpendicular to the direction of displacement of the piston. The piston can be longitudinally displaced in a substantially free manner in the cylinder when uncoupled. The piston and engaging section are formed as one piece (see Figure 4). A cannula can be fastened to the exit aperture is so desired.

Applicant is reminded that an anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data System, Inc.*, 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984). Furthermore, it is well settled that the law of anticipation does not required that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e. all limitation of the claims are found in the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference inherently discloses that element or limitation. *Standard Havens Products Inc. v. Gencor Industries Inc.*, 953 F.2d 1360, 21 USPQ 2d. 1321 (Fed. Cir. 1991).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kokernak.

Kokernak discloses the claimed invention except for the piston and the engaging section being formed as separate parts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the apparatus of Kokernak with the piston and

engaging section being formed as separate parts, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kokernak in view of Jacoby, Jr. (Reference U.S. Pat. No. 2,711,733 on PTO-1449).

Kokernak discloses the claimed invention except for the system having a cannula with an aperture and a coupling section. Kokernak discloses that a cannula or catheter can be attached for injecting fluid and Jacoby, Jr. discloses a cannula or catheter for injecting fluid. It would have been obvious to one skilled in the art at the time the invention was made to provide the apparatus of Kokernak with a cannula or catheter in view of Jacoby, Jr., in order to inject a fluid. It is noted that any cannula or catheter could be adapted for connection with the apparatus of Kokernak for the purpose of injecting a fluid.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fischione; Box, et al.; Ryan ; Armbruster, et al. ; Noce ; Barrington ; Crainich ; Keryluck, et al. ; and Thornhill, et al. are cited art of interest.

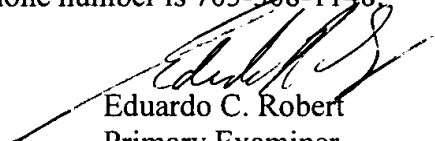
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C. Robert
December 15, 2002